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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,181	12/31/2003	Anu Krappe	79867	5000

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FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

LAM, CATHY FONG FONG

ART UNIT PAPER NUMBER

1775

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/750,181

Applicant(s)

KRAPPE ET AL.

Examiner

Cathy Lam

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,10,11 and 13-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,10,11 and 13-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-9, 6-13-2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

In view of the amendment and remarks filed on June 13, 2005, the pending claims continue to be unpatentable as following:

***Information Disclosure Statement***

1. The information disclosure statement filed June 13<sup>th</sup> 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant is required to submit a copy of DE 1973 7565 when responding to this office action.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19-21, 23, 25-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fidalgo et al (US 5690773).

It is noted by the Examiner that some claims are drafted in a product by process format. It is the product itself which must be new and unobvious. Unless some unexpected result is shown that occurs due to Applicant's specific process(es), different processing steps are not patentably distinguishing for claims to an article.

Art Unit: 1775

Fidalgo teaches a contact free card (or a smart card) comprised of an electronic module (4), an adhesive material (8) and thermoplastic protective sheets (2 & 10).

The electronic module (4) is comprised of a substrate (5), a coil (7) (or circuit pattern) and an IC chip (6) (col 3 L 55-57 & Figs. 1B-1D).

The electronic module (4) is either bonded to the thermoplastic sheet (2) by a bonding material or by pouring an adhesive material over the thermoplastic sheet (2) having the electronic module (4) (col 4 L 4-5 & L 10-11).

The adhesive material is a polyurethane (col 4 L 7). A second protective sheet (10) is formed over the polyurethane adhesive material (col 4 L 52-54).

Pressure is applied by using two metal plates onto the lower the upper thermoplastic sheets (2 & 10) (col 4 L 52-56).

The examiner takes the position that the substrate (5) in the electronic module (4) resembles the carrier web and the polyurethane adhesive material (8) resembles the intermediate layer of the present invention.

Fidalgo clearly teaches the structure of the present invention.

4. Claims 19-23, 25-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jarvis (GB 227 9612 A).

Jarvis teaches a smart card comprised of a printed circuit pattern (11), an integrated circuit, two intervening layers and two outer sheets (23,24).

The printed circuit pattern (11) is formed over a substrate sheet (12) and an IC is connected to the circuit pattern (P. 4 1<sup>st</sup> & 2<sup>nd</sup> full paragraph).

The printed circuit board (12) and the IC element (19) are sandwiched between two intervening layers which is of polyester adhesive. Then two outer sheets (23,24) are placed over the polyester adhesive (P. 4 last paragraph through P. 5 L 3).

The examiner takes the position that the substrate sheet (12) resembles the carrier web of the present invention and the polyester adhesive resembles the intermediate layer of the present invention.

5. Claims 1-5, 10-11, 13-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Haghiri-Tehrani et al (US 4450024).

Haghiri teaches an identification card comprised of an IC module and a printed circuit board.

The printed circuit board is comprised of a carrier plate which bears connection leads and the integrated circuit (col 1 L 5-8 L 53-54). Such IC module on a carrier plate is a carrier element (6).

The carrier element (6) is placed in a cavity (14) of a card core (11). Two cover films (12,13) are coated over the card core (11) as well as the carrier element (6) through the used of an adhesive (17) (col 4 L 26-30 & Figs. 3a-3b).

The adhesive (17) is a polyurethane adhesive (col 4 L 31-32). The cover films (20, 26) or (32,40) in other embodiments, can be polyethylene or polyester films, respectively (col 5 L 29-31 & L 51-54 & Figs. 5a & 5b).

6. Claims 1-5, 10-11 and 23-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chung (US 6404643).

Chung discloses a smart card comprised of an electronic module (210), an adhesive (306) and a substrate (308) (Fig. 9).

Chung discloses another embodiment of a smart card comprised of an electronic module (210) bonded to a substrate (202) through an adhesive (206) (Figs. 5 & 8).

The electronic module (210) is comprised of a printed wiring board and an electronic device (212). The printed wiring board (220) comprised of a dielectric substrate and conductive pattern (col 5 L 20-27).

The electronic module (210) is bonded to a substrate (308) through an adhesive (306) (col 8 L 47-57).

In another embodiment, the electronic module (210) is bonded to a substrate or a card blank (202) through an adhesive (206) (col 7 L 5-18).

Chung's disclosure meets the present invention in that the adhesive (306) and the substrate (308) (or the card blank (202)) can be taken as the intermediate layer and the moulded layer, respectively.

### ***Claim Rejections - 35 USC § 103***

7. Claims 1-5, 10-11 and 13-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fidalgo et al (US 5690773) or Jarvis (GB 227 9612A) or Haghiri-Tehrani et al (US 4450024) or Chung (US 6404643).

All of the above references teach the structure of the present invention.

The prior art however do not teach the carrier web for the circuit pattern and the IC being a polyester or a biaxially oriented polypropylene.

Since applicant has not specifically stated any advantages of using these polymeric materials for the carrier web. The examiner takes the position that choosing a material suitable for the invention is just a matter of design choice.

The examiner also takes the position that the prior art contact-less card or smart card functions the same as an RFID transponder.

### ***Response to Arguments***

8. Applicant's arguments filed on June 13, 2005 have been fully considered but they are not persuasive.

### ***Conclusion***

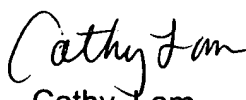
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (571) 272-1538. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Cathy Lam  
Primary Examiner  
Art Unit 1775

cfl  
August 23, 2005